

REMARKS

Applicants thank the Examiner for withdrawing the objections to the drawings under 37 C.F.R. 1.83(a), and furthermore for withdrawing the claim rejections under 35 U.S.C. §§ 102 and 112. By the foregoing amendment, Applicants have amended claim 18 to correct an informality.

In the final Office Action, claims 1-5, 17-20 and 33-36 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 4,214,230 to Fak et al. (hereinafter "Fak") in view of U.S. Patent Application Pub. No. 2001/0023415 of Keil (hereinafter "Keil"); claims 6-12, 22, 23, 28, 38, 39 and 44 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Fak in view of Keil further in view of U.S. Patent No. 4,223,403 to Konheim et al. (hereinafter "Konheim"); claims 16, 32 and 48 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 4,997,288 to Rosenow (hereinafter "Rosenow") in view of the publication *Secure Electronic Commerce* by Ford et al. (hereinafter "Ford"); and claims 21 and 37 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Fak in view of Ford. Applicants respectfully traverse the rejections of record.

Applicants note that the Examiner did not address pending claims 30, 31, 46, 47, 49 and 50 in the Final Office Action.

Independent claim 1 is directed to a method for generating identification data, comprising the steps of:

providing an ATM PIN related to a first transaction type which is an ATM transaction; and

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performing a cryptographic operation upon the ATM PIN, thereby generating a non-ATM electronic commerce PIN for use in a second transaction which is a non-ATM transaction.

As an initial matter, Fak and Keil are improperly combined references. Neither of the references includes a teaching or suggestion regarding their combination. Absent some teaching, suggestion, or incentive supporting the combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. (*ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933, 732 F.2d 1572, 1577 (Fed. Cir. 1984)).

Assuming *arguendo* that such combination is proper, Fak describes a method and apparatus for verifying that the bearer of a card is authorized to use the card. (See Fak, Abstract). As described in the portion of Fak cited in the Office Action, an account number and PIN are assigned to a cardholder, and a check number (PCN) is derived by generating a first cipher by encrypting the check number using the PIN in combination with a secret security number as a key. (See Fak, col. 2, lines 3-11). Fak fails to disclose several features recited in claim 1 as discussed above. First, Fak does not disclose performing a cryptographic operation on an ATM PIN to generate a non-ATM electronic commerce PIN for use in a non-ATM electronic commerce transaction (See, e.g., Specification, p. 4, wherein a user enters the non-ATM PIN in the course of a non-ATM electronic transaction). More generally, Fak does not disclose any type of cryptographic relationship between two different PIN numbers which are used in different types of transactions. Based on the removal of the prior rejections of the claims under §102 in view of Fak, it is presumed that the Examiner concedes that Fak does not disclose one or more features of the claims in their present form.

Keil is directed to a system and method for establishing a globally accessible debit account via a point of sale transaction terminal. (See Keil, Abstract; ¶ 0002). Contrary to the assertions in the Final Office Action, Keil does not cure the above-described deficiencies of Fak. The PIN described in Keil is certainly not derived from a cryptographic operation performed on an ATM PIN. In fact, the PIN of Keil bears no relation to an ATM PIN, cryptographic or otherwise. Rather, the PIN of Keil is either selected by the customer manually, which is the “preferred method,” or is otherwise randomly generated. (See Keil, ¶¶ 38 and 39). For these reasons, Keil cannot possibly cure the above-discussed deficiencies of Fak. Moreover, Keil is devoid of any discussion regarding cryptography respecting a PIN number. Accordingly, for at least these reasons, Keil viewed in combination with Fak, assuming such combination is proper, fails to render obvious independent claim 1 and depending claims 2-5.

Furthermore, the same bases for rejection of claims 1-5 were applied to claims 17-21 and 33-37. Applicants submit that for at least the same reasons discussion above, i.e., because Keil and Fak fail to disclose one or more limitations of claims 17-21 and claims 33-37, the rejection of these claims should also be withdrawn. Applicants respectfully submit that claims 1-5, 17-21 and 33-37 are in condition for allowance.

Claims 6-12, 22, 23, 28, 38, 39 and 44 are rejected under 35 U.S.A. 103(a) as allegedly being unpatentable over Fak in view of Keil further in view of Konheim. Applicants respectfully traverse these rejections.

Initially, Applicants again note that Fak and Keil are improperly combined, and the further combination of those references with Konheim is also improper. None of the

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references includes a teaching or suggestion of motivation supporting the combination. Absent some teaching, suggestion, or incentive supporting the combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. (*ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933, 732 F.2d 1572, 1577 (Fed. Cir. 1984)).

Konheim and Keil are likewise deficient of the above-discussed features recited in the claims. Konheim describes a cryptographic architecture for improving the security of cash-issuing or similar terminal systems when it is necessary to operate off-host. (See Konheim, Abstract). Konheim relates generally to various customer identification operations that are performed by a controller. (See Konheim, Abstract). The operations performed according to Konheim are performed without any user input between operations. This forecloses the possibility of utilizing any numbers generated during the procedure in the context of a second electronic commerce transaction which is of a different type from the first, as is recited in the claims of the present invention, and indeed teaches away from such a feature. Accordingly, because the combination of Fak, Keil and Konheim is improper, and further because these references fail to disclose at least the limitations discussed above, which are included by dependency in claims 6-13, 22, 23, 28, 38, 39 and 44, these claims cannot properly be rendered obvious by the combined references. Applicants respectfully request that these rejections be withdrawn. Additionally, claims 24-29, 40-43 and 45 were rejected on the same grounds as claims 6-13, 22, 23, 28, 38, 39 and 44, and should likewise be allowed as discussed above.

Claims 16, 32 and 48 ultimately depend from independent claims 14, 30 and 46. The Examiner did not address claims 14, 30, 31, 46, 47, 49 and 50. Applicants

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respectfully submit that these claims are in condition for allowance, and request that the Examiner indicate the allowance of such claims. Furthermore, for at least the same reasons that these claims should be allowed, Applicants respectfully submit that depending claims 16, 32 and 48 are also in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants submit that claims 1-50 as amended, all of the pending claims, are in condition for allowance. In the event that the application is not deemed in condition for allowance, the Examiner is invited to contact the undersigned in an effort to advance the prosecution of this application.

Respectfully submitted,



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